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10/561,424	03/07/2006	Wolfgang Brunner	23336-US	6332
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Roche Molecular Systems, Inc. Patent Law Department 4300 Hacienda Drive Pleasanton, CA 94588			EXAMINER	SASAKI, SHOGO
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,424	Applicant(s) BRUNNER, WOLFGANG
	Examiner Shogo Sasaki	Art Unit 1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 5/29/2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 5/29/2009 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/02506)
 Paper No(s)/Mail Date 5/18/2009
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

1. Amendments to claims 1 and 6 are acknowledged. An amendment to the specification is acknowledged. Cancellations of claims 12 and 13 were acknowledged in the previous office action.

Claim Interpretations

2. Claim 1 does not positively set forth "reaction vessels" as part of the claimed subject matter. Any further references to said elements were not given patentable weight even if those references further limit said unclaimed element.

3. Regarding claims 1, 5 and 6, recitations [claim 1] "for the non-rotatable holding of one or more reaction vessels," "for the gripping of a lid for the reaction vessel," "to take hold of the lid" and "when the lid is inserted into the area between the gripping jaws, it is held by the gripping jaws through frictional contact;" [claim 5] "to clamp and hold the reaction vessels;" and [claim 6] "to hold the reaction vessel" and "so that a reaction vessel inserted in the openings of the perforated plates is immobilized," which are directed to the manner in which a claimed apparatus is intended to be used do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Burt et al. (US 4674340).

Regarding claims 1-5, Burt et al. disclose a device (Fig. 1-6) comprising:

- a holding device (Fig. 1: 4 and 10; and Fig. 2);

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- a gripper (74), wherein the gripper has gripping jaws (82) and the gripper has no active operating device for opening and closing the gripping jaws;
- a rotating mechanism for rotatable holding of the gripper (64, 66, 68, 70 and 80);
- wherein the gripping jaws have insertion slopes (84);
- wherein the gripping jaws have on their gripping surfaces one or more cutting webs running at right-angles to the direction of rotation (88);
- wherein the cutting web projects beyond the gripping surface (Fig. 4 and 5); and
- wherein the holding device has a clamping mechanism (Fig. 2).

6. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Besnier (US 5533407).

Regarding claims 1-5, Besnier discloses a device (Fig. 1-7) comprising:

- a holding device (Fig. 4: 38);
- a gripper (Fig. 6: 76), wherein the gripper has gripping jaws (106) and the gripper has no active operating device for opening and closing the gripping jaws;
- a rotating mechanism for rotatable holding of the gripper (Fig. 6: 74, 88);
- wherein the gripping jaws have insertion slopes (Fig. 6: 106);
- wherein the gripping jaws have on their gripping surfaces one or more cutting webs running at right-angles to the direction of rotation (Fig. 6: 108);
- wherein the cutting web projects beyond the gripping surface (Fig. 6: 106 relative to 108); and
- wherein the holding device has a clamping mechanism (Fig. 4: 40).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt et al. (US 4674340); or Besnier (US 5533407), in view of Marino (US 6132684).

Regarding claims 6-8 and 11, Burt et al. or Besnier disclose all of the limitations as set forth above. However neither of them teaches the holding device specifically claimed in 6-11.

Marino discloses a holding apparatus for holding resilient plastic tubes (abstract; entire disclosure; and Fig. 1-12) comprising:

- three perforated plates (102, 104 and 106) arranged one above the other as a bottom plate (Fig. 8), a middle plate and a top plate, each of the perforated plates having a plurality of openings (Fig. 1-12), wherein the top and bottom perforated plates are arranged so as to be stationary, with the openings in the top and bottom perforated plates being flush with one another (column 4, lines 13-17; Fig. 6, 8 and 10), and the middle perforated plate is capable of sliding between a first position in which the openings in the middle perforated plate are aligned with the openings of the top and bottom perforated plates, and a second position in which the openings are arranged somewhat offset relative to the openings of the top and bottom perforated plates, so that a reaction vessel inserted in the openings of the perforated plates is immobilized (column 3, line 60-column 11, line 59);
- means for moving and fixing (Fig. 5, 7-9) the middle perforated plate in the second position;

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- wherein the middle perforated plate is mounted so as to slide in a single direction of sliding (column 3, line 60-column 11, line 59); and
- wherein the openings in the direction of sliding are wider than those at right-angles to the direction of sliding (column 3, line 60-column 11, line 59).

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claims 9 and 10, modified Burt et al. or modified Besnier disclose all of the limitations as set forth above. However neither of them teaches the projections provided in the holes of the plates, which extend into the interior of said holes.

Burt et al. and Besnier both teach the projections provided at the cap/lid contacting side of the cap/lid holding means (See 102 rejections). The projections are merely provided for giving the extra traction/friction to firmly hold the tubes in place. The very idea is already taught by both Burt et al. and Besnier.

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the same idea to the vessel holding side. The claim would have been obvious because "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense."

10. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt et al. (US 4674340); or Besnier (US 5533407), in view of Marino (US 6132684), and further in view of Hansen et al. (US 2003/0038071).

Regarding claims 9 and 10, modified Burt et al. or modified Besnier disclose all of the limitations as set forth above, however they do not explicitly show the projections provided at the holes of plates. Burt et al. and Besnier both teach the projections provided at the cap/lid contacting side of the cap/lid holding means (See 102 rejections).

Hansen et al. disclose a holding apparatus similar to the one disclosed by Marino (See Fig. 2-5 and 14-20). The holes (142) on plates of Hansen et al. include edges 144

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which are configured to engage with projections 146 on the exterior of the tubes 120 to prevent the tubes 120 from rotating within the openings 142 when, for example, a cap (not shown) is being screwed onto a top of the tube 120 ([0041]).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of modified Burt et al. or modified Besnier to incorporate projections as taught by Hansen et al., for the purpose of giving extra traction to hold the tubes in place. The claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Response to Arguments

11. Applicant's arguments filed 5/29/2009 have been fully considered.
12. The objections to the drawings are withdrawn.
13. Applicant's arguments with respect to the prior art rejections have been fully considered but they are not persuasive. (Please also see "Claim Interpretations" in paragraphs 2 and 3. This claim interpretation was also addressed in the last office action.).

On pages 7-9 of the reply, applicant stresses that Besnier and Burt et al. fail to disclose the frictional contact between the reaction vessel and the gripper. Examiner asserts that both Besnier and Burt et al. teach the frictional holding by the gripper. They may not explicitly state that there would be a frictional contact between the lids/caps of the vessels/tubes and the gripper. However the devices of Besnier and Burt et al. would not be able to perform the function of opening and/or closing of the lids/caps of the vessels/tubes without the friction. If two surfaces are in contact with each other, then there will have to be a friction between them unless the surfaces are treated to reduce frictions. Therefore the grippers of Besnier and Burt et al. are capable of holding the lids/caps of the vessels/tubes with friction. Further, in view of the claim interpretation, the currently presented claim 1 does not structurally limit the gripper to a gripper that exerts frictional force to the lid of the vessel.

In paragraph 5 of page 7, applicant argues that Burt et al. do not explicitly disclose "closing" the lids/caps of the vessels/tubes. Examiner asserts that the device of Burt et al. is capable of closing the cap. The device would only have to turn the rotatable gripper in the other way. However claim 1 does not structurally limit the device to the device for opening and closing the lids/caps of the vessels/tubes.

Applicant's arguments with respect to Besnier (from the last paragraph on page 7 to the first paragraph of page 8) have been fully considered. However it is the element 106 that is equivalent to the jaws in the rejections above; and in the rejections in the last office action. The element 108 would be the webs. (See bullet 5 of paragraph 6 above; and bullet 5 of paragraph 12 of the last office action.) The gripper (76) of Besnier does not actively operate the gripping jaws (106).

With respect to the 103(a) rejections, applicant only argues the asserted differences between the gripper of instant claims and the grippers of Besnier and Burt et al. The issue of the frictional contact is discussed above. Applicant did not argue why modifying the holding device of Besnier and Burt et al. with Marino would be improper.

Applicant's argument in the last paragraph on page 9 has been fully considered. Currently presented claim 1 does not structurally limit the gripper to hold the lid of the vessel when lifted from the vessel. However examiner asserts that the element 88 of Burt et al. is capable of holding the lid of a vessel even when the gripper is lifted above the vessel. That is because the friction between the element 88 and the lid would be just as large as the frictional force exerted by the gripper device disclosed in instant claim/application. The gripper claimed and disclosed are passive in providing the holding/frictional force.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shogo Sasaki whose telephone number is (571)270-7071. The examiner can normally be reached on Mon-Thur, 10:00am-6:30pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SS

7/22/09

/Brian R Gordon/
Primary Examiner, Art Unit 1797